

## REMARKS

By this amendment, claims 1-4, 9 and 12-14 have been amended. New claims 15-20 have been added. Claims 1-20 remain in the application. Support for the amendments can be found the specification and drawings, as originally filed. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration and allowance of the application, as amended, is respectfully requested.

### Claim Objections

Claim 9 was objected to because of informalities. As presented herein, claim 9 has been amended, as appropriate, to remove the informality. The objection to claim 9 is now believed overcome.

### Rejection under 35 U.S.C. §103

Claim 1 recites method for obtaining rating data, comprising:

- receiving a digital data transmission carrying at least one program;
- identifying a home jurisdiction of a receiver that receives the digital data transmission;
- determining whether rating data is provided in the digital data transmission for the at least one program for the home jurisdiction;
- using the rating data for the at least one program for the home jurisdiction, if available, to determine whether to block display of the at least one program; and
- if the rating data for the at least one program for the home jurisdiction is not available, using rating data that is provided in the digital data transmission for the at least one program for a foreign jurisdiction to determine whether to block display of the at least one program.

Claims 1-3 and 5-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fleming (U.S. Patent 6,449,766, hereinafter referred to as "**Fleming**") and deCarmo (U.S. Patent 6,567,979, hereinafter referred to as "**deCarmo**").

With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following reasons.

#### **1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Fleming** and **deCarmo** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Fleming** nor **deCarmo** teaches "if the rating data ... for the *home jurisdiction* is not available, using rating data that is provided in the *digital data transmission* ... for a *foreign jurisdiction* to determine whether to block display of the at least one program" (emphasis added) as is claimed in claim 1, it is

impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the **deCarmo** reference, by providing a parental management controller that "adjusts the default parental management enforcement level to local cultures and moral values" is directed to a system in which the *rating data* provided in the *digital data transmission for a foreign jurisdiction* is not used for determining whether to block display of the at least one program (see deCarmo at column 3, lines 6-8 and 32-35; column 6, lines 35-37; column 8, lines 11-12; and the abstract). Thus, this system clearly teaches away from claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **3. The Combination of References is Improper**

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another

compelling reason why the **Fleming** and **deCarmo** references cannot be applied to reject claim 1 under 35 U.S.C. §103.

§2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Fleming** nor **deCarmo** teaches, or even suggests, the desirability of the combination since neither reference teaches specifically "if the *rating data* ... for the *home jurisdiction* is not available, using rating data that is provided in the *digital data transmission* ... for a *foreign jurisdiction* to determine whether to block display of the at least one program" (emphasis added) as specified above and as claimed in claim 1.

Thus, it is clear that none of the references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination presented in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 2-3 and 5-11 depend from and further limit independent claim 1 and therefore are allowable as well. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claim 12 contains limitations similar to those of claim 1 and thus claim 12 is believed allowable for similar reasons stated herein with respect to overcoming the rejection of claim 1. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claim 13 contains limitations similar to those of claim 1 and thus claim 13 is believed allowable for similar reasons stated herein with respect to overcoming the rejection of claim 1. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claim 14 contains limitations similar to those of claim 1 and thus claim 14 is believed allowable for similar reasons stated herein with respect to overcoming the rejection of claim 1. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

#### **Allowable Subject Matter**

Claim 4 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Allowability of claim 4 is noted with appreciation. As presented herein, claim 4 has been rewritten in independent form including all of the limitations of the base claim. Accordingly, claim 4 is in *prima facie* condition for allowance.

#### **New Claims 15-20**

By this amendment, new claims 15-20 have been added to provide for more complete claim coverage. New claims 15-20 depend from and further limit allowable independent claim 4 and therefore are allowable as well.

**Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 4 and 12-14 are in condition for allowance. Claims 2-3 and 5-11 depend from and further limit independent claim 1 and therefore are allowable as well. Claims 15-20 depend from and further limit independent claim 4 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-20 is requested.

Respectfully submitted,

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a-32658.282